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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1001.1693101	
I hereby certify that this correspondence is being electronically transmitted to the USPTO addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on <u>August 24, 2010</u> Signature <u><i>JoAnn Lindman</i></u> Typed or printed name <u>JoAnn Lindman</u>		Application Number 10/618,785 Filed July 10, 2003 First Named Inventor Lawrence Wasicek Art Unit 3731 Examiner Nguyen, Vi X	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 50-0413.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>36,926</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 45%; text-align: center;">  Signature GLENN M. SEAGER Typed or printed name 612.677.9050 Telephone number <u>Aug 24, 2010</u> Date </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Appellant has carefully reviewed the Final Office Action of April 27, 2010 and the Advisory Action of July 9, 2010. Currently, claims 1-8, 10-15, 19-21, 24-29, 33, 34, 38-40, and 44-46 are pending in the application and have been rejected by the Examiner. Appellant hereby requests a pre-appeal conference and files this pre-appeal conference brief concurrently with a Notice of Appeal. Favorable consideration of the claims is respectfully requested.

Claims 1, 4-7, 10, 13, 20, 21, 24, 27, 34, 38-40, and 44-46 were rejected under 35 U.S.C. 103(a) as unpatentable over Daniel et al. (U.S. Patent No. 6,171,327). Daniel does not appear to teach all the claim limitations, as is required to establish a *prima facie* case of obviousness. As such, these claims are believed to be allowable over these references.

Nowhere does Daniel appear to disclose “a connector connecting the proximal section and the distal section of the elongate shaft, wherein the connector is fixedly secured to both the proximal section and the distal section ... and a filter coupled to the shaft” as recited in independent claim 1 and, *mutatis mutandis*, in independent claims 10, 24, 39, and 40.

In the Final Office Action and the Advisory Action, the Examiner clearly errs in asserting that Daniel is silent regarding a filter coupled to the shaft. Daniel discloses:

“Filter 21, including membrane 22 and frame 24 are attached to a wire 26 which extends the length of catheter 12. The proximal end of filter 21 is connected to wire 26 by two or more tails 28 extending from frame 24 to a stop 29. Stop 29 can be a clamp or wire winding, solder or other connector. At the distal end of filter 21, membrane 22 may be adhered to wire 26 by a suitable adhesive such as, for example, cyanoacrylates. (Col. 4, lines 29-36.)

Each of the filters (21, 121) disclosed by Daniel is attached to wire 26. The Examiner erroneously asserts in the Advisory Action that Daniel “teaches a filter 21 coupled to the shaft (fig. 9, element 112)”. Fig. 9, reproduced below for convenience, illustrates an alternate embodiment of a delivery catheter, 112, having distal housing 118

within which the wire 26 and attached filter 21 are disposed during delivery. Appellant directs attention to alternate catheter 112 of cited Fig. 9 (described at col. 6, lines 51-57) which generally corresponds to the two catheter sections (114, 116) joined by the collapsible braided section 132 of cited Fig. 4, said braid allowing the distal delivery housing to be withdrawn from filter 21, 121 and the distal portion of wire 26. Note that the filter 21 of Fig. 9 is attached to wire 26 and not to distal delivery housing 118 (or section 16) of catheter 112.

Fig. 9



Daniel does not disclose a filter attached to catheter 12, 112. Instead, Daniel teaches that filter 21 is disposed within housing 18, 118 which forms the distal end of catheter 12, 112 or of catheter 112 = 114/132/116 (Figs 3 and 4). Were the filter 21 to be coupled to catheter 112, it would be incapable of being deployed by withdrawing catheter 112 as taught by Daniel:

“Catheter 12 is then withdrawn distally such that filter 21 can expand in the direction shown by the arrows in FIG. 2.” (Col. 5, lines 24-26.)

and

“When catheter 112 is withdrawn in the direction of the arrow, braided section 132 is drawn tight for removal from wire 26 and filter 21 as explained above with respect to catheter 12.” (Col. 5, lines 61-64.)

Mounting the filter of Daniel on the exterior of the delivery catheter of Daniel as suggested by the Examiner would render the filter delivery system of Daniel unsatisfactory for its intended purpose of delivering the compressed filter 21 to the deployment site in a collapsed state within the catheter. (MPEP 2143.01 Part V.) Further, the modification would impermissibly alter the principle of operation of Daniel which relies upon delivery of filter 21, attached to wire 26, within filter housing 18, 118 disposed at the distal end of catheter 12, 112, said delivery occurring as the filter housing is withdrawn from around the filter, as noted above. (MPEP 2143.01 Part VI.)

The Examiner’s statement in the Advisory Action:

“Thus, the filter 21, fig. 9 of Daniel appears to be coupled or engaged to shaft 112.”,

clearly is in error. Instead, the filter is temporarily contained within the distal housing 118 of catheter 112. Although the Examiner has cited “Merriam-Webster online dictionary as an authority for the assertion that ‘The phrase “a filter coupled to the shaft” in the claim is broad enough to mean “something that joints, or links, or engages two things together”’, [sic] the entry incorrectly cited appears to be for the noun “couple. The definition for the transitive verb “couple”, having inflected form “coupled”, as of August 9, 2010, reads:

1 a : to connect for consideration together b : to join for combined effect

2 a : to fasten together

(Merriam-Webster's Online Dictionary, 11th Edition)

“Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.” *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998)

Here, the ordinary meaning in both contexts is clear. In the pending claims, the filter is “fastened to” the shaft which includes the connector. The shaft 26 of Daniel does not include a connector. Nothing Daniel teaches that the filter is not “fastened to” shaft 26 and is instead “fastened to” catheter 112. Indeed, the deployment function provided by the housing 18, 118 of catheter 12, 112 teaches away from the interpretation advanced by the Examiner in which the filter of Daniels would be attached to the interior of housing 18, 118 by a “joint or link” thereby rendering the filter incapable of deploying upon withdrawal of the distal delivery housing.

For at least these reasons, Daniel does not appear to teach all the claim limitations, as is required to establish a *prima facie* case of obviousness and Appellant respectfully requests that the rejections of independent claims 1, 10, 24, 39, and 40 be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

Accordingly, claims 4-7, 13, 20, 21, 27, 34, 38, and 44-46, which depend from nonobvious independent claims 1, 10, 24, 39, and 40 respectively, also are believed to be nonobvious and Appellant respectfully requests that the rejections be withdrawn.

Claims 2, 3, 6, 11-12, and 25-26 were rejected under 35 U.S.C. 103(a) as unpatentable over Daniel in view of Stevens et al. (U.S. Patent No. 6,029,671). Appellant must respectfully traverse this rejection.

As noted above, independent claims 1, 10, and 24 are nonobvious over Daniel. The addition of Stevens, said to disclose a proximal section having a first flexibility and a distal section having a second flexibility, does not overcome the deficiencies of Daniel as applied to independent claims 1 and 10, which do not include that limitation. With respect to claim 24 which does include the limitation, it should be noted that the disclosure of Stevens does not appear to overcome the remaining deficiencies of Daniel as discussed above. Further, Stevens does not appear to explicitly disclose that the two shaft segments necessarily have different flexibilities as a result of the selection of different materials for the two shaft segments. One of ordinary skill in the art would be aware that the flexibility of an element is a function of both the material and the geometry of the element in question and that a difference in composition does not necessarily result in a difference in flexibility which would be recognized as inherently present by one of ordinary skill in the art. (MPEP 2112.)

Flexibility, the inverse of stiffness, may be computed as the length of the member divided by the product of the modulus of elasticity and the second moment of area. Thus a unit beam having a first modulus of elasticity may have the same flexibility as, or example a unit beam having a different modulus of elasticity, but with a compensating second moment of area. Similarly, the flexibility of the beams may be matched by altering the relative lengths and/or by altering the relative lengths, moduli of elasticity, and second moments of area simultaneously. Thus a mere change in material is insufficient to necessarily (inherently) disclose a difference in flexibility.

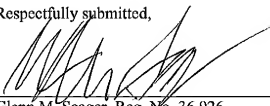
For at least these reasons, Daniel in view of Stevens does not appear to disclose all the claim limitations of independent claims 1, 10, and 24, as is required to establish a *prima facie* case of obviousness.

Accordingly claims 2, 3, 6, 11, 12, 25, and 26, which depend from nonobvious independent claims 1, 10, and 24 respectively, are also believed to be nonobvious and Appellant respectfully requests that the rejections be withdrawn.

For at least the reasons mentioned above, all of the pending claims are allowable over the cited prior art. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date: Aug. 24, 2010



Glenn M. Seager, Reg. No. 36,926
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Glenn.Seager@cstlaw.com
Tel: (612) 677-9050
Fax: (612)359-9349